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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,978	10/27/2003	Jacqueline C. Timans	DX0904KB1	4528
28008	7590	10/27/2005	EXAMINER	
DNAX RESEARCH, INC. LEGAL DEPARTMENT 901 CALIFORNIA AVENUE PALO ALTO, CA 94304			MERTZ, PREMA MARIA	
		ART UNIT	PAPER NUMBER	1646

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/694,978	TIMANS, JACQUELINE C.
	Examiner	Art Unit
	Prema M. Mertz	1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21-33 is/are pending in the application.
- 4a) Of the above claim(s) 28-33 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/27/03

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date 10/16/05
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of claims 21-27 in the reply filed on 9/21/2005 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 28-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

Specification

2a. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2b. On page 3, lines 10-11, there are dashes in the specification after "IL-1_" because the species of IL-1 has not been recited. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 21 embraces an antibody as it occurs *in vivo*. However, since it would that applicants do not intend to claim a naturally occurring product, such as an antibody circulating in

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an animal, amending the claim to require the hand-of-man i.e. isolated binding composition, would obviate this rejection.

Claims 22-24 are rejected insofar as they depend on claim 21 for their limitations.

Claim rejections-35 USC § 101/35 USC § 112, first paragraph

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility.

The claims are directed to binding compounds that bind a polypeptide of amino acid sequence set forth in SEQ ID NO: 2, kits comprising same, compositions comprising the same and a method of making antisera comprising the binding compound. The specification asserts that the invention has utility in that the IL-1 ζ is expected to have interleukin-1 like activities based on its structural similarity with known interleukins.

For example, the specification asserts that:

“The IL-1 ζ polypeptides will have a number of different biological activities, e.g., in the immune system, and will include inflammatory functions or other innate immunity responses. The IL-1 ζ polypeptides are homologous to other IL-1 proteins, but each have structural

differences. For example, a human IL-1 γ gene coding sequence probably has about 70% identity with the nucleotide coding sequence of mouse IL-1 γ , and similar measures of similarity will likely apply to the IL-1 ζ . At the amino acid level, there is also likely to be about 60% identity. This level of similarity suggests that the new IL-1 ζ proteins are related to the other IL-1 α , IL-1 β , IL-1RA, IL-1 γ , IL-1 δ , and IL-1 ϵ ."

(page 20, lines 21-32).

The assertion that the disclosed IL-1 ζ protein has biological activities similar to known IL-1 polypeptides cannot be accepted in the absence of supporting evidence, because the relevant literature reports examples of polypeptide families wherein individual members have distinct, and sometimes even opposite, biological activities. This is especially true for IL-1 polypeptides, as admitted in the specification at page 3, lines 10-14, wherein it is stated that:

"The interleukin-1 family of proteins includes the IL-1 α , the IL-1 β , the IL-IRA, and recently the IL-1 δ (also designated Interferon-Gamma Inducing Factor, IGIF). This related family of genes has been implicated in a broad range of biological functions."

The instant specification does not disclose a specific receptor to which SEQ ID NO: 2 binds. Finally, note Kumar et al. (2000, J. Biol. Chem. 275:10308-10314) who disclose that IL-1 δ is an antagonist of IL-1 ϵ , even though both polypeptides belong to the IL-1 family.

Other cytokine or growth factor polypeptide families are also known in the art to have different biological activities, despite a close structural relationship. For example, Tischer et al. (U.S. Patent 5,194,596) establishes that VEGF (a member of the PDGF, or platelet-derived growth factor, family) is mitogenic for vascular endothelial cells but

not for vascular smooth muscle cells, which is opposite to the mitogenic activity of naturally occurring PDGF which is mitogenic for vascular smooth muscle cells but not for vascular endothelial cells (column 2, line 46 to column 3, line 2). The differences between PDGF and VEGF are also seen in vivo, wherein endothelial-pericyte associations in the eye are disrupted by intraocular administration of PDGF but accelerated by intraocular administration of VEGF (Benjamin et al., 1998, Development 125:1591-1598, see Abstract and pp. 1594-1596).

In the transforming growth factor (TGF) family, Vukicevic et al. (1996, PNAS USA 93:9021-9026) disclose that OP-1, a member of the TGF- β family of proteins, has the ability to induce metanephrogenesis, whereas closely related TGF- β ; family members BMP-2 and TGF- β 1 had no effect on metanephrogenesis under identical conditions (p. 9023, paragraph bridging columns 1-2).

Generally, the art acknowledges that function cannot be predicted based solely on structural similarity to a protein found in the sequence databases. For example, Skolnick et al. (2000, Trends in Biotech. 18:34-39) state that knowing the protein structure by itself is insufficient to annotate a number of functional classes, and is also insufficient for annotating the specific details of protein function (see Box 2, p. 36).

Therefore, based on the discussions above concerning the specific examples of structurally similar proteins that have different functions, along with the art's recognition that one cannot rely upon structural similarity alone to determine functionality for new members of cytokine or growth factor polypeptide families, the assertion that the IL-1 ζ polypeptide recited in the claims has activities similar to previously characterized IL-1 polypeptides is not substantial. Significant further research would have been required of the skilled artisan to characterize the

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polypeptide of SEQ ID NO: 2 to determine its particular biological activities or other specific utilities.

In view of the evidence in the art that structural similarity between soluble polypeptides like interleukins, as well as other cytokines and growth factors, cannot accurately predict functional similarity, there is also no well-established utility for newly isolated IL-1 ζ .

The specification asserts several utilities for IL-1 ζ that are not necessarily related to its biological activities; however, none of these asserted utilities meets the three-pronged test of being credible, specific and substantial. Each will be addressed in turn:

a) *IL-1 ζ or its binding compounds can be used in therapy*: This asserted utility is credible, but it is not specific or substantial. In particular, the specification states at page 20, lines 21-24, that:

"The IL-1 ζ polypeptides will have a number of different biological activities, e.g., in the immune system, and will include inflammatory functions or other innate immunity responses."

Additionally on page 71, lines 1-5, the specification states that:

"IL-1 ζ being homologous members of the IL-1 family likely play a role in modulating of local and systemic inflammatory processes,"

but does not state what the role is, what types of inflammation involve IL-1 ζ , or how IL-1 ζ modulates the inflammation. The specification provides no clear nexus between any particular inflammatory state and any specific change in IL-1 ζ form or quantity. Since significant further research would be required before IL-1 ζ could be used in a real-world treatment of a specific disease, the asserted utility is not substantial. Also, a diverse group of chemical and environmental stimuli can be said to "play a role in modulating of local and systemic

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inflammatory processes", including cytokines, aspirin, lye, scratches, and ice. Some of these enhance inflammation (e.g., certain cytokines, lye, scratches) whereas others relieve inflammation (e.g., other cytokines, aspirin, ice). However, all of these diverse stimuli can be said to "modulate" or "play a role" in inflammation. Therefore, the assertion that IL-1 ζ plays a role in modulating inflammation is not a specific assertion of utility.

b) *IL-1 ζ can be used to screen for receptors, agonists or antagonists:* This asserted utility is credible and substantial, but it is not specific. The same can be done with any structurally and functionally unrelated polypeptide.

c) *IL-1 ζ can be used as a disease marker or as a tissue marker:* The specification does not provide a nexus between any particular disease state and an alteration in forms or levels of IL-1 ζ . Again, the specification asserts that IL-1 ζ : "likely plays a role in modulating of local and systemic inflammatory processes", and does not state what the role is, what types of inflammation involve IL-1 ζ , or how IL-1 ζ forms or levels are changed in inflamed tissues. Therefore, the assertion that IL-1 ζ can be used as an inflammation disease marker is credible, but it is not specific or substantial. Significant further research would be required to discover the nexus between a particular disease state and a particular alteration in IL-1 ζ forms or levels. Use as a tissue marker is credible, but it is not specific. Numerous structurally and functionally unrelated proteins can be used as tissue markers based on their expression patterns. This asserted utility is also not substantial since the tissue specific pattern of expression for SEQ ID NO: 2 was not disclosed in the specification, and would have to be determined empirically by the skilled artisan.

d) *IL-1 ζ can be used to make antibodies, and the antibodies can be used to identify*

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IL-1 ζ . This asserted utility is credible, but not specific or substantial. Antibodies can be made from any protein. Also, there is no indication of how to use the antibodies in a real-world use.

Therefore, since the specification does not disclose a specific, substantial and credible utility for the claimed binding compounds or the polypeptide they bind, the claims are rejected under 35 U.S.C. 101 for lack of utility.

Claims 21-27 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim rejections-35 USC § 112, second paragraph

5. Claims 22-27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 is rejected as vague and indefinite for reciting “glycosylated”. It is unclear what the metes and bounds of this term are.

Claim 23 is rejected as vague and indefinite for reciting the phrase “including” because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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Claim 24, lines 3-4, is rejected as vague and indefinite for reciting "or a source of the polypeptide of SEQ ID NOs: 2 or 4". It is unclear whether the polypeptide is part of the kit or only the source of the polypeptide is a part of the kit. It is suggested that the term "or" be deleted from the claim.

Claim 25 is indefinite because it recites "immunizing with an immunogenic amount", rather than "immunizing an animal with an immunogenic amount".

Claim 25, recites the limitation "the polypeptide of SEQ ID NOs: 2 or 4" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 27, line 2, is vague and indefinite because it recites "polypeptide of SEQ ID NOs:2 or 4" rather than the conventional "polypeptide of amino acid sequence set forth in SEQ ID NOs:2 or 4".

Claim 26 is vague and indefinite insofar as it depends on claim 25 for its limitations.

Claim rejections-35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 21-22, 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Yang Pan (U.S. Patent No. 6,117,654).

The reference discloses the cloning and expression of Tango-77 protein. The reference further discloses monoclonal, polyclonal, humanized, labeled antibodies and a method of making the antibodies to the Tango-77 protein (column 18, lines 35-58; column 19, lines 14-42). The claims are anticipated because the Tango-77 polypeptide sequence of the reference shares a sequence of over 50 amino acids which are 100% identical to the claimed amino acid sequence of SEQ ID NO:2 (see Sequence Comparison A, attached), thus an antibody to this region of Tango-77 would bind to the polypeptide of SEQ ID N0: 2, and the claims are anticipated.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pan (U.S. Patent No. 6,117,654) in view of the Stratagene catalog (1988, page 39).

The teachings of Pan have been set forth above in paragraph 6. However, these references do not teach the use of a kit. The Stratagene catalog does teach a motivation to combine reagents of use into a kit (page 39, column 1).

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It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to combine the antibodies as taught by Pan into a kit as taught by Stratagene since the Stratagene catalog teaches a motivation for combining reagents of use in any assay into a kit. It states that "Each kit provides two services: 1) a variety of different regents have been assembled and premixed specifically for a defined set of experiments. Thus one need not purchase gram quantities of different reagents, each of which is needed in only microgram amounts, when beginning a series of experiments. When one considers all of the unused chemicals that typically accumulate in weighing rooms, desiccators, and freezers, one quickly realizes that it is actually far more expensive for a small number of users to prepare most buffer solutions from the basic reagents. Stratagene provides only the quantities you will actually need, premixed and tested. In actuality, the kit format saves money and resources for everyone by dramatically reducing waste. 2) The other service provided in a kit is quality control" (page 39, column 1).

Conclusion

No claim is allowed.

Claims 21-27 are rejected.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (571) 272-0829.

Official papers filed by fax should be directed to (571) 273-8300. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Information regarding the status of an application may be obtained from the Patent application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Prema Mertz

Prema Mertz Ph.D., J.D.

Primary Examiner

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October 12, 2005

101	US-09-621-976-5315
102	US-09-621-976-5312
103	US-09-10-433-4129
104	US-09-543-68A-8234
105	US-09-270-767-57072
106	US-09-248-79A-22228
107	US-09-489-039A-9865
108	US-09-455-896-8
109	US-08-933-149-8
110	US-09-082-343-8
111	US-09-082-253-8
112	US-08-987-501-1
113	US-09-162-622-8
114	US-09-509-015-8
115	US-09-270-767-54725
116	PCT-WS96-18235-8
117	US-09-082-343-8
118	US-09-248-79A-26322
119	US-09-949-016-10599
120	US-09-540-236-2892
121	US-09-513-59C-4593
122	US-09-513-59C-5549
123	US-09-583-011-4975
124	US-09-139-537-283
125	US-09-770-767-61594
126	US-09-513-59C-4899
127	US-08-040-548-4
128	US-08-166-344-4
129	US-09-248-79A-27123
130	US-09-765-815-8
131	US-09-311-021-158
132	US-08-850-858A-14
133	US-09-621-976-5313
134	US-09-461-322-355
135	US-10-012-541-355
136	US-10-115-122-355
137	US-09-904-540-11364
138	US-09-134-01C-3090
139	US-09-205-258-279
140	US-09-270-767-31764
141	US-09-270-767-44981
142	US-08-409-231A-7
143	US-08-470-298B-12
144	US-08-470-298B-12
145	US-09-732-210-589
146	US-09-732-210-590
147	US-08-820-825-11
148	US-09-023-073A-7
149	US-09-307-817-11
150	US-09-361-737-7

SEQUENCE COMPARISON A

ATTENDENTS

RESULT 1
US-09-398-412B-2 ; Sequence 2, Application US/09398412B
; Patent No. 6680380 ; GENERAL INFORMATION:
; APPLICANT: Timans, Jacqueline C.
; TITLE OF INVENTION: Nucleic acids and methods
; TITLE OF INVENTION: methods
; FILE REFERENCE: DX0904K
; CURRENT APPLICATION NUMBER: US 09/39
; CURRENT FILING DATE: 1999-09-17
; PRIORITY APPLICATION NUMBER: US 60/1009
; PRIORITY FILING DATE: 1998-09-18
; NUMBER OF SEQ ID NOS: 15
; SOFTWARE: PatentIn version 3.1
SEQ ID NO 2
LENGTH: 218
TYPE: PRT

RESULT 3
US-09-128-155-9
Sequence 9, Application US/09128155
| Patent No. 6117654
| GENERAL INFORMATION:
| APPLICANT: Pan, Yang
| TITLE OF INVENTION: NOVEL MOLECULES OF TANGO-77 RELATED PROTEIN FAMILY
| TITLE OF INVENTION: AND USES THEREOF
| FILE REFERENCE: 09/04/052001
| CURRENT APPLICATION NUMBER: US/09/128,155
| CURRENT FILING DATE: 1998-08-03
| EARLIER APPLICATION NUMBER: US 60/091,650
| EARLIER FILING DATE: 1998-07-02
| EARLIER APPLICATION NUMBER: US 60/054,646
| EARLIER FILING DATE: 1997-08-04
| NUMBER OF SEQ ID NOS: 18
| SOFTWARE: FastSEQ for Windows Version 3.0

1101	4	US-09-621-976-5315
1102	4	US-09-621-5221
1103	4	US-09-107-433-4129
1104	5	US-09-943-61A-8234
1105	4	US-09-270-767-57072
1106	4	US-09-248-756A-2328
1107	6	2.8
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1111	6	2.8
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148	6	2.8
149	6	2.8
150	6	2.8

Sequence 5315, Ap
Sequence 5321, Ap
; ORGANISM: Homo sapiens
US-09-398-412B-2

SEQUENCE COMPARISON A

SEQUENCE COMPATISON

ALIGNMENTS

RESULT : US-09-128-155-9 Sequence 9, Application US/09128155

Patent No. 6117654
GENERAL INFORMATION:
APPLICANT: Fan, Yang
TITLE OF INVENTION: NOVEL MOLECULES OF TANGO-77 RELATED PROTEIN FAMILY
TITLE OF INVENTION: AND USES THEREOF
FILE REFERENCE: 09404/052001
CURRENT APPLICATION NUMBER: US/09/128,155
CURRENT FILING DATE: 1998-08-03
EARLIER APPLICATION NUMBER: US 60/091,650
EARLIER FILING DATE: 1998-07-02
EARLIER APPLICATION NUMBER: US 60/054,646
EARLIER FILING DATE: 1997-08-04
NUMBER OF SEQ ID NOS: 18
SOFTWARE: EASSTIE for Windows Version 3.0